

COMMENTS

Applicants note that the claims have been amended to clarify the status of claim 1 as a generic linking claim and to place the claims in better condition for examination. Support for the amendments is found in the specification, at least, in the claims as filed, at page 16, lines 18-23; at page 111, lines 8-16; and at page 124, lines 2-4. Applicants have not narrowed the claims and thus do not intend to disclaim any subject matter through the amendments.

RESPONSE TO RESTRICTION REQUIREMENT

In response to the Restriction Requirement which the Examiner imposed Applicants elect, with traverse, to prosecute Group I claims, *e.g.*, claims 1 and 12-16, drawn to at least 135 nucleotides of a glutamine synthetase promoter, classified in class 536, subclass 24.33 for example. Applicants traverse on the basis that all of the claims are generically linked by claim 1 and therefore must be considered together with this claim, as explained below.

In a restriction requirement, generic or other linking claims should not be associated with any one of the linked inventions, and this fact should be clearly stated on the record. MPEP §814. This is because such claims must be examined with the linked invention that may be elected. Here, all of the pending claims include the limitations of claim 1 and therefore are generically linked by this claim. Specifically, all of the pending claims either depend from claim 1, or incorporate the limitations of this claim by reference. The presence of this linking claim must therefore be indicated on the record and the claims considered together. MPEP §814.

With respect to the foregoing Applicants respectfully draw attention to the decision by the Court of Appeals for the Federal Circuit in *In re Michael P. Doyle*, which notes that an applicant may prosecute generic, linking claims “without running afoul of the restriction

requirement *because they are linking claims.*” 293 F.3d 1355, 1360 (Fed. Cir., 2002), *citing* MPEP §809.03 (8th ed. 2001) (emphasis added). Indeed, the Court held that the failure to present generic claims in the original prosecution of an application was an error correctable by broadening reissue. *Id.* at 1361-1362. Further, the Federal Circuit noted that allowance of a linking claim prompts the examination of covered claims, stating that “[t]he MPEP expressly provides that ‘[I]f a linking claim is allowed, the examiner must thereafter examine species if the linking claim is generic thereto, or he or she must examine the claims to the nonelected inventions that are linked to the elected invention by such allowed linking claim.’” *Id.* at 1362., *citing* MPEP § 809.04 (emphasis added by the Court). Consideration of all of the claims on this basis is thus requested.

Applicants additionally note that the M.P.E.P. requires that “[i]f the search and examination of an entire application can be made without serious burden, the examiner *must* examine it on the merits, even though it includes claims to independent or distinct inventions.” (emphasis added) M.P.E.P. §803. Here, a search and examination of all of the current claims would not cause a serious burden because all of the claims incorporate the limitations of claim 1. Therefore, all of the claims are related and fall within a discrete scope of subject matter.

Upon the searching of claim 1 and the determination that the claim is novel and nonobvious by the Examiner, there is *no* additional burden in searching the remaining claims because they must by definition also be novel and nonobvious based on the incorporation of the limitations of claim 1. The relevant standard in the M.P.E.P. requires a *serious* burden on the examiner in order to support a proper restriction. The relation among the pending claims here eliminates any such serious burden. Removal of the restriction is therefore respectfully requested.

CONCLUSION

In view of the foregoing Applicants respectfully request favorable consideration of this case and withdrawal of the Restriction Requirement.

The Examiner is invited to contact the undersigned attorney at (512) 536-3085 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,



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